

perpendicular to the radial direction] to thereby form the fluff on the polishing cloth so that the polishing cloth can evenly and continuously polish the semiconductor device.

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REMARKS

Applicants' counsel wishes to thank Examiner Nguyen for the telephonic discussion in which Examiner Nguyen indicated that the arguments for patentability set forth in the Response of March 20, 2000 had overcome the rejections based on the prior art of record, and wherein the Examiner provided a summary of the present rejection of the claims based on the recapture doctrine. In addition, Applicants' counsel wishes to thank Supervisory Examiner David A. Scherbel for the telephonic discussion of September 29, 2000 in which Examiner Scherbel summarized the present rejection and discussed the most appropriate manner for responding to the outstanding Office Action. Accordingly, in light of those discussions, Applicants have provided the following remarks and respectfully request allowance of the pending claims.

Claims 1-21 stand rejected under 35 U.S.C. §251 as being an improper recapture of claimed subject matter surrendered in the application for the patent upon which the present reissue is based. In this regard, the Examiner contends that the claims sought to be reissued include a broadening aspect, and that the prosecution history of the original patent shows that the broadening aspect was previously surrendered. In particular, the Examiner contends that the limitations sought to be deleted in the reissue claims, namely, "an annular shape with," "radial direction of," and "and perpendicular to the radial direction," provide a broadening aspect to the reissue claims and that these limitations were added in the amendment filed on May 17, 1996 to overcome the rejections based on Bombardier, et al. '021 in view of Japan reference '870, Beasley '963, Ruark, et al. '681, and Holzhauser as set forth in the Office Action of February 26, 1996. Accordingly, the Examiner contends that the failure to appreciate the more narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. §251 and that the broader scope surrendered in the application for patent cannot be recaptured in the present reissue application. Applicants respectfully disagree and traverse this rejection.

The guidelines for applying the recapture doctrine were set forth by the Court of Appeals for the Federal Circuit in In re Clement, 131 F.3d at 1468-1469 (Fed. Cir. 1997):

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under *Mentor [Mentor Corp. v. Coloplast, Inc.]*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must

determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

Also See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 2889, 294-95 (Fed. Cir. 1984).

In this original application, the limitations "an annular shape with," "radial direction of," and "and perpendicular to the radial direction," were all unnecessary to overcome the prior art of record. The reissue application has sought to remove these unnecessary limitations from the claims because the Applicants failed to appreciate the full scope of the invention during prosecution of the original patent. This failure to appreciate the scope of an invention is clearly one of the categories of error under §251 that are correctable by reissue. Clement, 131 F.3d at 1468.

Having concluded that the above unnecessary limitations, the removal of which provides a claim scope that is broader than the scope of the original patent claims, are appropriate for removal during reissue under §251, an analysis must be made as to whether the broader aspects of the reissue claims relate to surrendered subject matter. From a review of the prosecution history, and in particular the amendment filed on May 17, 1996 alluded to by the Examiner, it is clear that the limitations "radial direction of" and "and perpendicular to the radial direction" were not specifically argued in that amendment to overcome the prior art of record, and thus were not impermissibly "surrendered."

In determining whether claim amendments are permissible under §251, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable. Hester Industries, 142 F.3d 1472, 1481 (Fed. Cir. 1998). In Hester, the patent applicant repeatedly specifically argued that two limitations distinguished the original claims from the prior art of record. These limitations were also the primary bases for distinguishing the broadest independent claim from the prior art, with the patent applicant specifically arguing that each of two limitations were "critical" and "very material" with respect to

patentability.¹

In examining the prosecution history of the instant application for evidence of an admission by Applicants that subject matter has been surrendered, it is clear that the unnecessary limitations "radial direction of" and "and perpendicular to the radial direction" were not specifically argued as "necessary" or "critical" to patentability. At best, these two limitations were mentioned as being within the scope of the claims; however, Applicants did not specifically argue that these limitations were necessary for patentability.

MPEP Section 1412.02, in "Example (A)" under the section "Criteria For Determining That Subject Matter Has Been Surrendered", states:

"[t]he argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. In other words, a general "boiler plate" sentence will not be sufficient to establish recapture." (Emphasis added).

Moreover, as noted in MPEP Section 1412.02, such a "general argument will not, by itself, be sufficient to establish surrender and recapture."

With respect to the amendment of May 17, 1996, Applicants concede that the limitation "an annular shape" was specifically argued with respect to Japanese reference '870 (For example, May 17, 1996 amendment, page 7, third paragraph). With respect to Beasley, the arguments in the May 17, 1996 response provided that "[i]n the invention, the tool has an annular shape and is curved in the radial direction. Beasley does not have the annular shape with a curvature in the radial direction." (Page 7, third paragraph). Moreover, the amendment and remarks of the May 17, 1996 amendment argued that "the cleaning member 7 in Japan '870 has a rod shape, not the annular shape as in the invention..." (Page 8, fourth paragraph).

On the other hand, while it appears that the limitation "an annular shape with" may have been specifically argued in the amendment filed on May 17, 1996, the remaining limitations at issue, namely, "radial direction of," and "and perpendicular to the radial direction" are not specifically addressed in the arguments. Instead, these two unnecessary limitations were mentioned passively within the scope of the claims. As a result, the application of recapture to these limitations is improper.

In light of the foregoing remarks, Applicants have amended claim 1 in a manner which retains the limitation "an annular shape with" within the scope of claim 1. Accordingly in light of

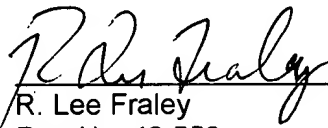
¹ With respect to one limitation, the patent applicant asserted in 27 instances in six papers that the limitation distinguished the claimed invention from the prior art, and with respect to the other limitation, the patent applicant asserted in 15 instances that the limitation was necessary. Hester at 1482.

these remarks, Applicants submit that pending claims 1-21 are allowable over the prior art of record, that the scope of the claims in the patent was in error within the meaning of 35 U.S.C. §251, and that the claims as currently amended are allowable.

In view of the foregoing, Applicants respectfully submit that all of the pending claims fully comply with 35 U.S.C. §112, the recapture doctrine as articulated by the Court of Appeals for the Federal Circuit, and are allowable over the prior art of record. Reconsideration of the application and allowance of all pending claims as amended herein is earnestly solicited. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,

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